

## **REMARKS**

Applicants have amended claims 2, 3, 6, 7, 8, 11-17 during prosecution of this patent application. Applicants are not conceding in this patent application that said amended and canceled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicants respectfully reserve the right to pursue said amended and canceled claims, and other claims, in one or more continuations and/or divisional patent applications.

The Examiner objected to the drawings.

The Examiner rejected claims 7, 8 and 17 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement.

The Examiner rejected claims 1-17 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner rejected claims 1-6, 9-16 on the grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claim 1 of U.S. Patent No. 6728374 in view of Thomke et al (4817138).

The Examiner rejected claims 1-6, 9-16 rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Thomke et al (4817138), and further in view of applicant's admitted prior art (specification).

Applicants respectfully traverse the § 112 and 103 rejections with the following arguments:

**35 U.S.C. § 112 1<sup>st</sup> ¶**

The Examiner rejected claims 7, 8 and 17 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement.

Applicant respectfully draws the Examiner's attention to the relevant portion of the instant specification which teaches enablement of the movement of the speaker arrangement. Starting on page 6, line 17 through page 7, line 16 teaches one having ordinary skill in the art to practice the invention without undue experimentation.

“It is possible for the bone conduction loudspeaker 4 to be slidably mounted on the casing 1 so as to be movable in a longitudinal direction of the casing 1. It is also possible for the bone conduction loudspeaker 4 to be mounted on the casing 1 so as to perform a spherical motion (see Fig. 3).

In the case where the bone conduction loudspeaker 4 is slidably moved, it is necessary to form a slit in a mounting surface of the speech receiving opening 3, in which mounting surface the bone conduction loudspeaker 4 is mounted. The bone conduction loudspeaker 4 is provided with a neck-shaped support portion 13. This support portion 13 is provided with a narrow waist portion, which is capable of passing through the slit of the mounting surface in the opening 3 and therefore capable of slidably moving along this slit. Further, in the case where the spherical motion is wanted to be realized, it is necessary to form an engaging hole in the mounting surface of the speech receiving opening 3 for mounting the bone conduction loudspeaker 4 therein, in which engaging hole the neck-shaped support portion 13 of the bone conduction loudspeaker 4 is so engaged as to be rocked relative to the casing 1.

When the above-mentioned construction is employed, it is possible to adjust the telephone transmitter/receiver in length, and also capable of adjusting the bone conduction loudspeaker 4 in abutting angle of its surface through which the bone conduction loudspeaker 4 is brought into contact with the user's head portion. Through such adjustment in length and abutting angle, it is possible for the telephone transmitter/receiver of the present invention to be used in various types of telephone

devices, which vary in size and shape of the mounting portion of the telephone transmitter/receiver.”

In addition to quoting the specification, claims 7, 8, and 17 have been amended to further comport with the enablement requirement. The claim amendments should provide the Examiner with clarification about being “within the enclosure” because the claims no longer recite having the bone conduction loudspeaker “arranged in,” rather the claims now point out that the bone conduction loudspeaker is mounted on the surface of the speech receiving opening. Therefore, Applicant respectfully requests reconsideration and removal of the enablement rejection.

**35 U.S.C. § 112 2nd ¶**

The Examiner rejected claims 1-17 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant respectfully draws the Examiner attention to the instant specification:

“A connection cord 6, which has the same construction as that of a conventional connection cord, is connected with both the microphone and the bone conduction loudspeaker 4. Connected with the amplifier 5 is another connection cord 7. These two cords 6, 7 have their portions extending outside the casing 1 twisted together so as to be formed into a single line. Alternatively, it is also possible to insert these cords 6, 7 into a single piece of tube 8. The tube 8 is a preferable one of possible options. The connection cords 6, 7 have a pair of their inner portions in the casing 1 and another pair of their outer portions extending outside the casing 1 connected with each other through a modular jack. This modular jack is mounted on a bottom surface of the casing 1.” (page 4)

Furthermore, the specification reads:

“Before using the telephone transmitter/receiver of the present invention, it is necessary to insert the telephone connector 9 into the jack 16 of the telephone main body 15 and also necessary to insert the DC plug of the AC adapter into the DC jack 10. As for the power supply for energizing the amplifier 5, the power supply is available by using the AC adapter. In the case where the AC adapter 11 is directly connected with the power supply connection cord 7, the AC adapter 11 is inserted into a domestic power supply receptacle before using.” (page 5).

Based on the cited portions of the specification and amendments to the claims, Applicants respectfully assert that the claims are not indefinite. As the specification discloses, the connector cords are of conventional construction.

## **Double Patenting**

The Examiner rejected claims 1-6, 9-16 on the grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claim 1 of U.S. Patent No. 6728374 in view of Thomke et al (4817138).

Applicant respectfully contends that the claim limitations are patentably distinct from claim 1 of the '374 patent in view of Thomke et al because claim 1 of the '374 patent actually teaches away from the claim limitations. The Examiner states that claim 1 recites a telephone handset with a bone conduction device, and admits that it does not disclose an amplifier, AC/DC adaptor to supply power and an additional cord to couple the handset to the rest of the phone system. Furthermore, the Examiner contends that it would have been obvious to implement an enclosure for the purpose of supporting/protecting the claimed handset, an amplifier to drive the output signal to the speaker, and the disclosed cabling connection for the purpose of coupling the disclosed functional components. However, the '374 patent discloses that the handset is "small, light in weight" (abstract). When using the invention in the '374 patent, it is "brought into close contact with the user's face in the vicinity of his/her ear" (col.2 ln.62-64). Additionally, the Figures clearly show that the object of the device is to provide a sleek, non-bulky, portable-like handset; the claim limitations disclose a bone conduction loudspeaker arranged in a handset coupled to a telephone main body. Having a larger handset coupled with a telephone main body would frustrate the operation of the '374 patent, thus it teaches away from the claimed invention. Furthermore, the '374 patent discloses "the microphone portion is made of resilient flexible materials having an affinity for the user's skin" (col.3 ln.2-4). The claim limitations disclose a microphone arranged in a speech sending opening of a handset.

Therefore, one having skill in the art simply would not be motivated to combine the teachings of Thomke et al. with the '374 patent because it would frustrate the purpose of the invention. Because claim 1 of the '374 patent teaches away from the claim limitations, they are non-obvious and patentably distinct from each other.

### **35 U.S.C. § 103**

The Examiner rejected claims 1-6, 9-16 under 35 U.S.C. 103(a) as allegedly being unpatentable over Thomke et al. (4817138), and further in view of applicants' admitted prior art (specification).

Applicants respectfully contend that the claim limitations are not unpatentable over Thomke et al. and further in view of applicants' allegedly admitted prior art (specification) because Thomke et al. and further in view of applicants' allegedly admitted prior art (specification) do not teach or suggest each and every feature of the claim limitations. The Examiner admits that Thomke et al. does not disclose a bone conduction speaker, but asserts that Applicant admits in the background section that use of bone conduction speakers are well known in the art. While the background section states that using bone conduction speakers might be known to enhance the ability to catch sound in a high-noise environment, **absent in the cited references is a bone conduction speaker with an amplifier and a power supply connection cord connecting the amplifier to an AC adapter.** Thomke et al. discloses a casing of the base being fitted with another microphone and has a shape such that the base may be used as a second handset, thereby enabling two people to converse at the same time with one outside person if the person is connected to two lines.

Alternatively, the claim limitations relate to a telephone transmitter/receiver, and more particularly to a telephone transmitter/receiver, which is connected with a telephone main body for performing bone conduction communication by using a bone conduction loudspeaker, wherein the telephone transmitter/receiver is previously mounted on a new set of telephone device or applied to an already existing set of telephone device. Thomke et al. does not disclose an amplifier connected to the bone conduction loudspeaker and a power supply connection cord

connecting the amplifier to an AC adapter. Ostensibly, the instant claim limitations do not enable two people to converse at the same time with an outside person.

Furthermore, *In re Kumar*, 76 USPQ2d 1048 (Fed. Cir. 2005) is the current controlling case law regarding the requirement that the prior art must enable claimed subject matter. In *In re Kumar*, the Federal Circuit states: “Although published subject matter is “prior art” for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must **enable** a person of ordinary skill to make and use the invention.... To render **a later invention** unpatentable for obviousness, the prior art must **enable** a person of ordinary skill in the field to make and use the **later invention**.” (emphasis added), *Kumar*, 76 USPQ2d at 1052, 1053. The Examiner asserts, “[i]t would have been obvious to one of ordinary skill in the art at the time of the application to implement a bone conduction speaker with the speech circuit driving circuitry of Thomke for the advantage of improved hearing in noisy environments.” The Examiner has not met the requisite burden of *demonstrating how Thomke et al. enables* the inclusion of a bone conduction speaker into the Thomke invention. Thus, Thomke cannot render the claimed invention obvious because it lacks requisite disclosure that would render enablement, and Applicant’s alleged admission alone is insufficient to maintain an obviousness rejection.

Based on the preceding arguments, Applicants respectfully maintain that the claim limitations are not unpatentable over Thomke et al. and further in view of applicants’ allegedly admitted prior art (specification) and that claim 1 is in condition for allowance. Since claims 2-17 depend from claim 1, Applicants contend that claims 2-17 are likewise in condition for allowance.



## **CONCLUSION**

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 19-0513.

Dated: January 23, 2009

Respectfully submitted,

/Arlen L. Olsen/

Arlen L. Olsen  
Registration No. 37,543  
Customer No.: 05409

Schmeiser, Olsen & Watts  
22 Century Hill Drive, Suite 302  
Latham, New York 12110  
Tel. (518) 220-1850  
Fax: (518) 220-1857  
Email: aolsen@iplawusa.com